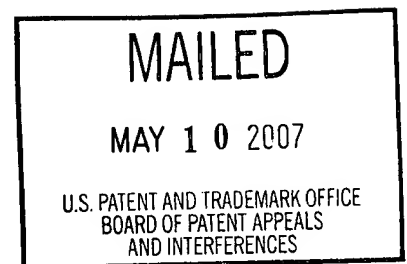


1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte PAUL LEVI WILLIAMS, JR., and
11 MARCELLOUS P. FRYE, JR.
12

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14 Appeal 2007-0774
15 Application 09/741,994
16 Technology Center 3600
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19 Oral Hearing Held: April 3, 2007
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23 Before MURRIEL CRAWFORD, TERRY OWENS, and ROBERT NAPPI
24 Administrative Patent Judges
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27 ON BEHALF OF THE APPELLANT:
28

29 PHILLIP J. ARTICOLA, ESQUIRE
30 Foley & Lardner
31 2000 K Street, NW, Suite 500
32 Washington, DC 20007-5109
33

34 The above-entitled matter came to be heard on April 3, 2007,
35 commencing at approximately 9:50 a.m., at the United States Patent and
36 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Elizabeth
37 J. Walker, Reporter.

1

2 MR. ARTICOLA: Good morning. I am Phillip Articola. I was
3 hoping to start by describing the problems with the prior art, a description of
4 the invention, and go to the claim under the prior art, which is pretty
5 straightforward.

6 This invention deals with electronic commerce -- electronic data
7 interchange through which companies are compliant with each other via
8 electronic -- no paper at all, like the patent office does here.

9 So, in that regard, there is a need to make that process better and more
10 easy for users. And so, in effect, a user who wants to trade with IBM or GE
11 would need to be compatible with those companies' electronic servers. So,
12 in that regard, company A has to -- gets the necessary software equipment
13 to be able to send invoices and purchase orders to those companies that it
14 wants to trade with.

15 So turning now to the invention. The user would communicate with a
16 host server and, by doing so, the user would authenticate trading partners
17 that the user wants to trade with -- like I said, IBM, GE. That being done,
18 the host server provides the user with information -- automatically provides
19 the information concerning what applications are necessary to trade with
20 these trading partners identified by the user. And, in that case, then, the

1 user, at that point, can decide to purchase those software applications and
2 then, at some later date, trade with those trading partners of interest.

3 The claims are basically recite these features.

4 The key element of the claims is the element of automatically
5 determining by the host server suitable electronic commerce EDI products or
6 services for the user based, at least in part, on the requirements information
7 from the selected trading partners. The host server receives information
8 from the user, "I want to trade with IBM and G.E." The host server then
9 pulls information from a data base and finds, "Oh, GE has EDI type X," and,
10 therefore, I need to provide the user, "Here is the information you would
11 need. Here is the software you would need to communicate with GE and
12 IBM, EDI format Y and, therefore, if you want to communicate with IBM or
13 GE" -- whatever I said -- "you would need this set of applications to trade
14 with them," and the user could then decide to purchase those applications.

15 These claims were rejected under 102 over EDI Consulting Services,
16 Inc. It basically describes this company that provides EDI service for users
17 and has several things it does. It has experts who can help companies with
18 needs and mapping support, "Let us build your maps," and talks about, thus,
19 given enough time and money, that anyone can map, but "they could do it in
20 a more time-efficient, cost-efficient method than you can do this." Then it
21 goes on to other features that they do -- testing, and are supported by EDI
22 staff.

1 The key element was mapping support. And the examiner had stated
2 that, well, since EDI Consulting uses a mapping means of converting a
3 document from one type to a document of another type -- say, from a source
4 to a destination document -- that, in effect, performs suitability EDI projects
5 or service for the users and, in effect, operates as the host server in our
6 invention.

7 In our reply briefs and appeal brief we argued, no, it really doesn't do
8 this. It's really an expert helping the user along. And in the building of
9 maps, you can envision -- let's say I call EDI Consulting Services and say, "I
10 want a map to convert this purchase order of format X to this invoice of
11 format Y. And EDI Consulting Services says, "Oh, great. We will do that
12 for you." And I provide them with the information.

13 Now, it may well be the case that the purchase order of type X is my
14 purchase order and the invoice of type Y is maybe GE's invoice. But I'm
15 providing all the information to GE Consulting Services, and GE Consulting
16 Services will then do what they do. They will provide the software and say,
17 "Phil, here is the maps we generated for you based on the information you
18 provided to us."

19 That's a lot different than me going online to a host server and saying,
20 "I want to be a trading partner with IBM. I don't know anything about IBM,
21 but I want to be a trading partner with IBM." And the host server says,
22 "Okay. Here you go. Here's all the information that you need. Here's the

1 application that you need to be a trading partner with IBM." I have not
2 provided them with the invoices of IBM. I don't have even know them.

3 And so, in that regard -- there is arguments about inherency, and what
4 have you -- it just appears that EDI Consulting Services just doesn't do the
5 things that are comparable to the features recited in Claim 1 and the other
6 counterpart independent claims.

7 And that's basically the major issue in terms of -- there's some back
8 and forth in reply briefs, or what have you about this and that, but it just
9 seems like how the examiner is interpreting what this document does, the
10 prior art, and how we are saying, well, it just didn't meet the specific claim
11 limitations of the automatic determining by a host server of EDI products
12 and services.

13 JUDGE OWENS: So you are interpreting "ECS maps every day" as
14 meaning they provide mapping software.

15 MR. ARTICOLA: Well, they are helping you. I mean, they are
16 basically -- you're giving them information you need. "I need to map A to
17 B." I assume that you need to give them the information they need to do the
18 map. And if so, a map isn't usually a source to a destination; it's a target to
19 another one.

20 So I have a document of this format. I want to convert it to a
21 document of another format. And they say, "Give me that information, and

1 I'll provide you with the means to have this document with this format to
2 become this document with the other format." And that is the mapping.

3 JUDGE OWENS: So you are interpreting that as providing the
4 means, rather than doing the mapping. "ECS maps every day" means
5 providing the means, not doing the mapping. That is how you are
6 interpreting it.

7 MR. ARTICOLA: I'm not sure I understand exactly what you are
8 trying to say there, but --

9 JUDGE OWENS: If "ECS maps every day" means they do the
10 mapping in response to your input, that indicates it is automatically
11 determining. Now, if it means they provide you with the software to do it
12 yourself, then it would mean something else. So that seems to be the issue.

13 MR. ARTICOLA: Well, it's also an issue, I think, more that you are
14 providing them with both your stuff -- your format -- and the format of who
15 you want to trade with.

16 JUDGE NAPPI: Doesn't it say in here that, "we already know what
17 your trading partners have"? I mean, you come down to the next one, "It's
18 likely you've already done EDI for your trading partners." I mean, that
19 suggests that they already know -- if you go to them and say, "I want to
20 trade with GE," they already know what GE needs.

21 MR. ARTICOLA: There is that argument about what that really
22 means. I mean, it sounds like it's under testing, and so they're saying, you

1 know, we can do this back and forth communication between you and GE
2 because we've done work with GE and we do work for you and, therefore,
3 we are experienced in this area and, therefore, we can -- you know, trust us
4 because we've done it before."

5 I think to go beyond that and say, "Well, since we have done work for
6 GE, we're going to give you all of GE's stuff" -- that seems to be beyond
7 what I would think this means. I mean, I hope they are not trying to say,
8 "We're going to give you all the information that we've done for GE in the
9 past. We're just going -- " that "We're experienced, and we do this thing all
10 the time and, therefore, you can trust us because, you know, we have done
11 work for just about every else, and so we can do it for you, as well."

12 But that's different from saying, "I want to communicate with A, B, C
13 companies. Provide me with what I need." Here, you could argue, well, at
14 best, you are providing them with information of the companies you want to
15 trade with because you have to give information for them to do the maps.

16 And, in our case, you're not doing that because you're not providing --
17 you don't know what the maps are. You don't know what GE and IBM --
18 what their requirements are. You're hoping that the host server is going to
19 provide you with what you need -- the applications that, "Okay. Look,
20 download the software, and you will be able to communicate with GE and
21 IBM."

1 JUDGE OWENS: Well, you don't know, but it seems like they do.
2 So they could provide you with the necessary software to convert to GE.

3 MR. ARTICOLA: We'll, that's different from the maps. The maps
4 they're providing you with -- if I want a map, I'm going to have to give them
5 information necessary to map from A to B. So are you going to say, well,
6 just because mapping is a separate section from testing -- I think that's --
7 those are two separate areas entirely.

8 Mapping is, "We can help you do mapping. Give us all the
9 information we need to do the mapping." It doesn't say, "Well, just because,
10 under testing, it says we've done work for your trading partners" -- which I
11 would argue is just "We're experienced." And to go beyond that to say,
12 "Well, that means that we can do mapping without you even giving us the
13 other side of the map -- "

14 JUDGE OWENS: But the question is whether the testing portion
15 would influence how you interpret the mapping portion.

16 MR. ARTICOLA: Right. And so I argue, well, the mapping -- it just
17 seems a little too much to say, "We can do mapping for you. Just give us
18 your side of the map, and we'll do the rest for you." That's a lot. That's
19 reading a whole lot into that that I think is not there." I think that's saying,
20 "We can build your maps, which means you're going to have to help us and
21 give us everything on both sides of the map, and we will do it." And that's

1 different from saying, "Just give us who you want to trade with, and we'll
2 give you everything you need to do that."

3 And that seemed to be the gist of the arguments, the going back and
4 forth. And, obviously, I think they are clearly defined here. I think you
5 have hit the issues which are: What does EDI disclosure suggest to one of
6 ordinary skill in the art?

7 JUDGE OWENS: Okay. Thank you.

8 MR. ARTICOLA: Thank you so much.

9 Whereupon, at 10:02 a.m., the hearing in the above-entitled matter
10 was concluded.